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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,902	03/29/2004	Hiroto Yukawa	2004-0499	1092
513	7590	04/08/2005	EXAMINER	
WENDEROTH, LIND & PONACK, L.L.P.			LEE, SIN J	
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DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/810,902

Applicant(s)

YUKAWA ET AL.

Examiner

Sin J. Lee

Art Unit

1752

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/376,304.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Due to new ground of rejection, the following rejection is made *non-final*.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claims 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takemura et al (5,759,739) in view of Yoshimoto et al (EP 0 540 032 A1) and Suwa et al (6,187,504 B1).

Takemura teaches (col.1, lines 10-12, col.2, lines 27-35, col.6, lines 53-55) a positive resist composition of chemically amplified type comprising alkali-soluble resin, a dissolution inhibitor of the formula (2) or (3), a photoacid generator, and an organic solvent.

The chemical formula for Takemura's photoacid generator is $(R^1)_nMX$ wherein M is sulfonium or iodonium, and X is p-toluenesulfonate or trifluoromethanesulfonate (see col.2, lines 40-48). Since there are only two choices for "X", one of ordinary skill in the art would immediately envisage "X" to be trifluoromethanesulfonate anion. Therefore, Takemura teaches present onium salt compound having a fluoroalkylsulfonate as the anionic constituent.

Takemura teaches (col.5, lines 36-65, col.6, lines 39-45) that their dissolution inhibitor of formula (2) can be readily prepared by copolymerizing hydroxystyrene, substituted or *unsubstituted styrene*, *t-butyl (meth)acrylate*, and (meth)acrylic acid at a molar ratio of m:x:y:z (wherein the molar ratio z can be zero). Based on this teaching,

one of ordinary skill in the art would immediately envisage Takemura's dissolution inhibitor being a copolymer of hydroxystyrene, unsubstituted styrene, t-butyl (meth)acrylate. Therefore, the prior art teaches present copolymeric resin consisting of monomeric units of hydroxystyrene, monomeric units of styrene, and monomeric units of tert-alkylacrylate or methacrylate. Takemura furthermore teaches (col.5, lines 36-65) that the molar ratio m (for the hydroxystyrene monomer unit) can preferably be 0.3-0.7 (30-70 mol%), the molar ratio x (for the substituted or unsubstituted styrene monomer unit) can preferably be 0 to 0.9 (0-90 mol%), and the molar ratio y (for the t-butyl (meth)acrylate monomer unit) can preferably be 0-0.9 (0-90 mol%). Since these molar ratios (or mol%) overlap with present ranges of claim 5, the prior art's teaching would render obvious present ranges of claim 5 *prima facie* obvious. In the case "where the [claimed] ranges overlap or lie inside ranges disclosed by the prior art," a *prima facie* case of obviousness would exist which may be overcome by a showing of unexpected results, In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976).

As to the presently claimed amounts for the present component (A) and (B), Takemura teaches (col.6, lines 46-48) that their dissolution inhibitor is used in the amount of 7-40 wt% of the total weight of their components and that their photoacid generator is used in the amount of 0.5-15 wt% of the total weight of their components (see col.5, lines 1-3). Based on this teaching, one of ordinary skill in the art would immediately envisage using 40 wt% of Takemura's dissolution inhibitor of formula (2) because 40 wt% is clearly disclosed as the higher end of the taught range. When one converts the amount of 0.5-15 wt.% of Takemura's photoacid generator based on 100

wt.% of Takemura's dissolution inhibitor, this gives 1.25-37.5 wt.% of Takemura's photoacid generator based on 100 wt.% of Takemura's dissolution inhibitor. Since this range overlaps with present range of 1-20 parts by weight of the acid generating compound (B), the prior art's teaching would render obvious present range *prima facie* obvious. See In re Wertheim, supra. Therefore, Takemura teaches present components (A) and (B).

With respect to present component (C), Yoshimoto et al, a prior art which also teaches a positive type photoresist composition comprising a resin having anti-alkali dissolution groups in the molecules (which becomes alkali soluble by a reaction with a cid) a photoacid generating compound, teaches in pg.3, lines 16-24 that the adhesiveness of a resist to a substrate is markedly improved by adding organic phosphorus acid compound to the photoresist in an amount of 0.001 to 10 wt.% (based on the weight of the resin). As *preferred* examples for the organic phosphorous compound, Yoshimoto teaches (see pg.9, lines 43-45) phenylphosphinic acid as well as phenylphosphonic acid (see Table 1 on pg.16). Since Takemura teaches (col.9, lines 25-28) that their resist compositions are coated on a silicon substrate (Yoshimoto also teaches a silicon substrate –see pg.10, lines 15-16), it would have been obvious for one of ordinary skill in the art to add an organic phosphorus acid compound such as *phenylphosphinic acid* or *phenylphosphonic acid* to Takemura's photoresist in order to improve the adhesiveness of the resist to a substrate as taught by Yoshimoto et al. Also, since the taught amount for the phosphorus acid compound to be added overlaps with the presently claimed ranges (0.01-5 parts by wt. in claim 5), the prior art's range

would have made the present range *prima facie* obvious, In re Wertheim, supra.

Therefore, Takemura in view of Yoshimoto would render obvious present component (C).

With respect to present component (D), Suwa et al, a prior art which teaches (col.2, lines 14-55) a positive -tone radiation sensitive resin composition comprising a photoacid generator, alkali-soluble resin and an alkali solubility control agent, teaches (col.28, lines 30-58) the use of a Lewis base additive (which exhibits an action as a Lewis base to the acid produced from the acid generator) such as nitrogen-containing basic compounds in order to improve perpendicularity of resist pattern side walls. Since Takemura's photoresist composition also comprises a photoacid generator, it would have been obvious to one of ordinary skill in the art to add a nitrogen-containing basic compound to Takemura's resist composition in order to improve perpendicularity of resist pattern side walls as taught by Suwa et al. As examples for the nitrogen-containing basic compounds, Suwa teaches amine compounds, imidazole compounds, pyridine compounds and nitrogen-containing heterocyclic compounds, and Suwa includes triethylamine, tributylamine, as well as triethanolamine as more specific examples for the amine compound. Based on Suwa's teaching, it would have been obvious to one of ordinary skill in the art to add triethylamine, tributylamine, or triethanolamine into Takemura's resist composition with a reasonable expectation of improving perpendicularity of resist pattern side walls as taught by Suwa et al. Therefore, Takemura in view of Suwa would render obvious present component (D) (since Suwa teaches (col.28, lines 59-61) the amount of the Lewis base additive, which

exhibits an action as a Lewis base to the acid produced from the acid generator, to be 0.05-1 mol for 1 mol of the acid generator, it is the Examiner's position that the prior art teaches the use of present component (D) in an amount sufficient to exhibit an acid quenching effect).

Therefore, Takemura in view of Yoshimoto and Suwa would render obvious present inventions of claims 5-9.

The Examiner acknowledges that Takemura's composition also contains an alkali-soluble resin (as his component (B)) which is not being claimed in present claims 5-9. However, it is the Examiner's position that the presence of Takemura's alkali-soluble resin *does not materially affect the basic and novel characteristics of the presently claimed invention*, and thus it is the Examiner's position that Takemura in view of Yoshimoto and Suwa still teaches present composition of claim 5. In MPEP 2111.03, it is stated that the transitional phrase "*consisting essentially of*" limits the scope of a claim to the specified materials or steps "*and those that do not materially affect the basic and novel characteristic(s)*" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). As one of the preferred example of the alkali-soluble resin, Takemura teaches polyhydroxystyrene in which some hydroxyl groups are replaced by t-butoxycarbonyl groups (see col.5, lines 17-24). Such resinous compound is also mentioned in present specification (pg.6, second full paragraph) as one of the particular examples for the resinous compounds suitable as the present component (A) (besides, present specification states (pg.7, first full paragraph) that it is

optional that the component (A) is a combination of two kinds of more of those resinous compounds listed on pg.6-7)). Thus, it is the Examiner's position that Takemura's alkali-soluble resin would not materially affect the basic and novel characteristics of the presently claimed invention.

Therefore, for the reasons stated above, it is still the Examiner's position that Takemura in view of Yoshimoto and Suwa would render obvious present inventions of claims 5-9.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 5, 6, and 8-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-14 of U.S.

Patent No. 6,340,553 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

With respect to present component (A), in claim 8 of Pat.'553, those % ranges for the amount of hydroxystyrene units, styrene units and 1-alkylcyclohexyl (meth)acrylate

units overlap with those in present claim 5 and thus would have made present range *prima facie* obvious. Claim 14 of Pat.'553 teaches present component (B). Claims 12 and 13 of Pat.'553 render obvious present component (C) (phenyl phosphonic acid). Claims 9-11 teaches present component (D). Claim 8 of Pat.'553 also teaches an organic solvent (present component (E)). Therefore, claims 8-14 of Pat.'553 render obvious present inventions of claims 5, 6, and 8-10.

Response to Arguments

6. Applicants argue that Takemura's essential component (B) is excluded from the present "consists essentially of" format and that "the solubility reducing component" (B) of Takemura would be expected to alter solubility which is a function of present component (A) and thus alters the basic and novel characteristics of the present claims. However, Takemura's component (B) is not "the solubility reducing component" as called by applicants. It is an alkali-soluble resin (see col.5, lines 17-24). Thus, applicants' argument that the presence of Takemura's component (B) would alter the basic and novel characteristics of present claims because it is a solubility-reducing component is not persuasive.

Applicants argue that in view of the differences between Suwa's composition and Takemura's, there is no reason to expect that adding a Lewis base as suggested by Suwa would also have similar effects in the very different composition of Takemura. However, both Suwa and Takemura teach a positive photoresist composition that contains a photoacid generator (Suwa et al, like Takemura, teaches a positive -tone radiation sensitive resin composition comprising a photoacid generator, alkali-soluble

resin and an alkali solubility control agent). Since Suwa teaches the use of a Lewis base additive (which exhibits an action as a Lewis base to the acid produced from the acid generator) in order to improve perpendicularity of resist pattern side walls, and since Takemura's photoresist composition also comprises a photoacid generator, it would have been obvious to one of ordinary skill in the art to add a nitrogen-containing basic compound to Takemura's resist composition in order to improve perpendicularity of resist pattern side walls as taught by Suwa et al.

Applicants also argue that there would be no reason to expect that the phosphorous derivatives of Yoshimoto would enhance the very different compositions of Takemura and that since Yoshimoto also discloses phenylenediamine, there would be no reason to select the amine of Suwa. First of all, Yoshimoto does not teach or suggest the use of an organic base in order to improve perpendicularity of resist pattern sidewalls as Suwa does. Secondly, as already explained above, Yoshimoto et al also teaches a positive type photoresist composition comprising a resin having anti-alkali dissolution groups in the molecules (which becomes alkali soluble by a reaction with a cid) a photoacid generating compound, and the reference teaches that adhesiveness of a resist to a substrate is markedly improved by adding organic phosphorus acid compound to the photoresist. Since Takemura teaches that their resist compositions are coated on a silicon substrate (Yoshimoto also teaches a silicon substrate –see pg.10, lines 15-16), it would have been obvious for one of ordinary skill in the art to add an organic phosphorus acid compound such as *phenylphosphinic acid* or

phenylphosphonic acid to Takemura's photoresist in order to improve the adhesiveness of the resist to a substrate as taught by Yoshimoto et al.

Also, Applicants argue that present Examples 1-6 shown the line width of 0.18 um whereas the line width in the Examples of Takemura are about 0.25 um or more. However, present rejection is not being made on Takemura alone. It is based on Takemura in view of Yoshimoto and Suwa. It is the Examiner's position that *the composition taught by Takemura in view of Yoshimoto and Suwa* (which is the same composition as the present composition) would inherently be able to produce the present line width.

For the reasons stated above, present rejections still stand.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sin J. Lee whose telephone number is 571-272-1333. The examiner can normally be reached on Monday-Friday from 9:00 am EST to 5:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

S. J. Lee

S. Lee

April 4, 2005

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